

## **REMARKS**

Presently pending in this application are claims 1-33. Claims 1, 11, and 25 have been amended. New claim 33 has been added. Applicant submits that no new matter has been added by this Amendment.

### **Rejections under 35 U.S.C. § 102**

The Examiner has rejected claims 1-13, 23, and 24 under 35 U.S.C. § 102(b) as being anticipated by German Disclosure of Invention DE 42 29 976 A1 to Finkenauer *et al.* ("Finkenauer"). This rejection is respectfully traversed.

Independent claim 1 has been amended to recite that the barrel has "a side surface" and "an actuator located on said side surface."

In contrast, Finkenauer fails to disclose or suggest an actuator "located on said side surface" of the barrel, as recited in claim 1. Accordingly, independent claim 1 and all claims depending therefrom are patentable over Finkenauer. Withdrawal of this rejection and allowance of independent claim 1 and all claims depending therefrom are respectfully requested.

Independent claim 11 has been amended to define the barrel as having "an open end a closed end," and to recite that the channel extends "between said open end and said closed end." Independent claim 11 has also been amended to recite that the writing element has "a writing end," and that the writing end is "within said channel" when the writing element is in a retracted position and extends "through and outside said open end" when the writing element is in an extended position. Such amendments with respect to the writing end are for clarification purposes and are not considered to narrow the scope of independent claim 11.

Finkenauer discloses a writing instrument with a barrel having two open ends. One of the ends allows the tip of the writing cartridge to extend out of the barrel. An actuator extends out of the second open end of the barrel. Thus, Finkenauer fails to disclose or suggest a barrel with a "closed" end, as recited in claim 11. Accordingly, independent claim 11 and all claims depending therefrom are patentable over Finkenauer. Withdrawal of this rejection and allowance of independent claim 11 and all claims depending therefrom are respectfully requested.

The Examiner has rejected claims 1-6, 8-19, 21, 23, and 24 under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,200,050 to Lin ("Lin"). This rejection is respectfully traversed.

As discussed above, independent claim 1 has been amended to recite that the barrel has "an actuator located on said side surface."

Lin fails to disclose or suggest an actuator "located on said side surface" of the barrel. Accordingly, independent claim 1 and all claims depending therefrom are patentable over Lin. Withdrawal of this rejection and allowance of independent claim 1 and all claims depending therefrom are respectfully requested.

As discussed above, independent claim 11 has been amended to define the barrel as having "an open end a closed end," and to recite that the channel extends between said open end and said closed end." Independent claim 11 has also been amended to recite that the writing element has "a writing end," and that the writing end is "within said channel" where the writing element is in a retracted position and extends "through and outside said open end" when the writing element is in an extended position.

Like Finkenauer, Lin also discloses a writing instrument with a barrel having two open ends. One of the open ends allows the tip of the writing cartridge to extend out of the barrel. An actuator extends out of the second open end of the barrel. Thus, Lin fails to disclose or suggest a barrel with a "closed" end, as recited in claim 11. Accordingly, independent claim 11 and all claims depending therefrom are patentable over Lin. Withdrawal of this rejection and allowance of independent claim 11 and all claims depending therefrom are respectfully requested.

The Examiner has rejected claims 25, 27, 28, and 30 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,564,849 to Greer, Jr. ("Greer"). This rejection is respectfully traversed.

Independent claim 25 has been amended to recite a barrel having a "substantially straight, longitudinal channel."

In contrast, Greer discloses a writing instrument having a barrel with a curved channel with a pair of ink cartridges disposed in said channel that are selectively extendable and retractable through the openings in the barrel.

Greer fails to disclose or suggest "a substantially straight longitudinal channel," as recited in amended claim 25. Accordingly, independent claim 25 and all claims depending

therefrom are patentable over Greer. Withdrawal of this rejection and allowance of independent claim 25 and all claims depending therefrom are respectfully requested.

**Rejection under 35 U.S.C. § 103**

The Examiner has rejected claims 26 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Greer in light of United States Patent No. 4,227,823 to Kitzerow ("Kitezerow"). This rejection is respectfully traversed.

Kitzerow discloses a retractable ballpoint pen, the channel of which is substantially circular.

As shown above, Greer fails to disclose, teach, or suggest each and every element of amended claim 25, from which claims 26 and 31. Furthermore, Kitzerow also fails to remedy the deficiency of Greer, as it does not disclose, teach, or suggest "a substantially straight longitudinal" channel, as recited by claim 25. Accordingly, claims 26 and 31 are patentable over Greer in light of Kitzerow. Withdrawal of this rejection and allowance of claims 26 and 31 are respectfully requested.

**Objections to Claims**

The Examiner has objected to claims 20, 22, 29, and 32 as being dependent upon a rejected base claim, but indicated that claims 20, 22, 29, and 32 would be allowable if rewritten in independent form. This objection has been respectfully obviated.

As shown above, independent claim 11, from which claims 20 and 22 depend, and independent claim 25, from which claims 29 and 32 depend, are now allowable over the prior art. Accordingly, claims 20, 22, 29 and 32 are patentable in dependent form, and withdrawal of this rejection and allowance of claims 20, 22, 29, and 32 are respectfully requested.

In light of the above Amendment and remarks, Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney if a telephone call could help resolve any remaining items.

No fee believed due with the submission of this response. Should any additional fees be due, please charge any such fees for this submission to Pennie & Edmonds LLP deposit account no. 16-1150.

Respectfully submitted,

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